

REMARKS

I. Introduction

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 102-211 remain pending. Claims 102, 148, 194, 195, 196, 197, 198, 199, 200, 201, 202, 206, 210, and 211 are independent claims. Claims 103-147, 149-193, 203-205, and 207-209 are dependent claims.

On 22 April 2003 applicants' representative spoke with Examiner Arthur Duran by telephone concerning the correct numbering of the pending claims. The examiner indicated that the USPTO had renumbered the claims entered by the preliminary amendment filed 18 July 2002 and the amendment filed 6 September 2002 pursuant to 37 CFR 1.126.

II. Rejections under 35 USC 103(a) Based Upon USP 6,321,208 to Barnett

The examiner rejects claims 102-211 under 35 USC 103(a) as being unpatentable over Barnett.

A. Rejections Under 103(a) of Claims 102, 148, 194-202, 206, 210, and 211

1. The Examiner's Argument

In support of the rejections of claims 102, 148, 194-202, 206, 210, and 211 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claims 102, 148, 194, 195, 196, 197, 198, 199, 200, 201, 202, 206, 210, 211: Barnett discloses a computer implemented method, system comprising the steps of

transmitting a customer's customer identification from a kiosk to a computer (col 3, lines 35-45; col 4, lines 48-60; col 14, lines 15-30), said computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product and (col 8, lines 14-25; col 11, lines 24-30; col 4, lines 40-49) (2) containing customer shopping habit data associated with said customer identification (col 8, lines 33-38; col 12, lines 37-63; col 13, lines 24-35);

determining incentive offer criteria satisfied by said customer's customer shopping habit communicating to said kiosk an incentive offer for said product associated with said incentive offer criteria satisfied by said customer's customer shopping habit

data (col 9, lines 45-67; col 12, lines 37-63);
inputting at a POS terminal of a retail store a customer identification in association with an identification of an item of a product being purchased by said customer (col 7, lines 35-55; col 4, lines 64-67; Fig. 1); and
providing said incentive to said customer when said customer purchases said product at said POS terminal (col 4, lines 64-67; Fig. 1).

Barnett does not explicitly disclose that the personal computer where the coupons are selected can be a kiosk. Barnett does disclose that the coupon obtainment device can be wired or wireless (col 13, lines 35-45; col 6, lines 35-45) and thus flexible as to its location. Barnett further discloses a kiosk where coupons can be selected and obtained (col 3, lines 35-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's coupon selection and obtainment device or computer can be a kiosk. One would have been motivated to do this because a kiosk is a convenient way of obtaining coupons.

Barnett further discloses the step of determining incentive offers for said customer based upon product stock availability (col 10, lines 31-38; col 10, lines 20-25) and that items in stock and coupons can be correlate along with customer shopping habit data (col 10, lines 22-25; col 10, lines 27-30; col 10, lines 44-47).

Barnett further discloses that a supervisor computer can transfer incentive information to a store level computer (Fig. 1). Barnett further discloses displaying at said kiosk for said customer (1) broadcast special offers and (2) offers that depend upon whether said customer's customer shopping habit data meets said incentive offer criteria (col 10, lines 1-30; col 12, lines 37-62).

Barnett further discloses the steps of determining a number of product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria; ranking said product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria;

displaying, based upon said ranking, a predetermined number of the ranked incentive offers at said kiosk to said customer (col 9, lines 15-22; col 10, lines 1-30; col 12, lines 37-62; col 10, lines 1-16). [Office action page 2 lines 13 to page 4 line 22.]

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

2. Disputed Factual Assertions

a. The "...transmitting a customer's identification from a kiosk to a computer..." Recitation - Claims 102, 148, 194, 195, 200-202, and 206.

The examiner asserts that column 3 lines 35-45 in Barnett discloses "transmitting a customer's identification from a kiosk to a computer." That assertion is incorrect. Barnett at column 3 lines 35-45 does not disclose "transmitting a customer's identification from a kiosk to a computer." Column 3 lines 35-45 in Barnett states that:

U.S. Pat. No. 5,176,224 to Spector teaches a closed-loop coupon system which consists of a kiosk type printer station located at a retail store. The kiosk is linked to the manufacturers in order to obtain specific coupon information. The consumer selects the desired coupon at the kiosk, and the coupon is printed and dispensed.

The reference to the Spector patent does not imply that Barnett's system included a kiosk or that Barnett's method included data transmission from a kiosk.

The examiner asserts that column 4 lines 48-60 in Barnett also discloses "transmitting a customer's identification from a kiosk to a computer." That assertion is incorrect. Barnett at column 4 lines 48-60 does not disclose "transmitting a customer's identification from a kiosk to a computer." Column 4 lines 48-60 in Barnett states that:

The remote user computer in the present invention comprises interface means for providing user interaction with the centrally located repository, a memory, and a coupon data management program. The coupon data management program is implemented by the computer for requesting coupon data from the centrally located repository, for storing in the memory coupon data transmitted from the centrally located repository, and for generating printable coupon data from the stored coupon data. The remote user computer also comprises a coupon output buffer operatively associated with the data management program for storing the printable coupon data generated by said coupon data management program.

Barnett's remote user computer is not a kiosk as defined in the pending claims because one of ordinary skill in the art would recognize from the disclosure and from the definition of "kiosk" that a kiosk should be easily accessible to large numbers of customers, while a remote personal computer as taught by Barnett is designed to work only for a single user. See, e.g., Barnett

column 6 line 66 to column 7 line 11.

The examiner asserts that column 1 lines 15-30 in Barnett discloses "transmitting a customer's identification from a kiosk to a computer." That assertion is incorrect. Barnett at column 1 lines 15-30 does not disclose "transmitting a customer's identification from a kiosk to a computer." Column 1 lines 15-30 in Barnett states that:

Significant time is spent clipping and sorting coupons, discarding expired coupons and organizing current coupons for use on shopping trips. Conventional coupon distribution results in significant wasted time due to consumers' attempts to manage their coupon use.

Coupons are delivered to consumers through a variety of media. The primary coupon distribution is via pull-out sections in newspapers, which are known as free standing inserts (FSIs). This accounts for just over 80% of coupons used. Other methods of distribution include in-store shelf coupon dispensers, check-out coupons (generally issued based on the customer's current purchase), register receipt coupons, in-product coupons, instant peel-off on-product coupons and direct mail coupons. In addition to manufacturers' coupons, consumers use retail store coupons, such as those issued by large retail chains on a weekly basis. [Barnett at column 1 lines 15-30]

This passage Barnett appears not to be relevant to use of kiosks; rather, the passage describes the processing and distribution of coupons.

Thus, Barnett does not disclose "transmitting a customer's identification from a kiosk to a computer." Claims 102, 148, 194, 195, and 200-202, and 206 recite "transmitting a customer's identification from a kiosk to a computer." There is no teaching in Barnett suggesting substituting a kiosk for Barnett's remote personal computer. Therefore, Barnett does not teach or suggest the subject matter of these claims. Therefore, the rejections of claims 102, 148, 194, 195, and 200-202, and 206 are improper and should be withdrawn.

- b. **The "...computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product..." Recitation - Claims 102, 148, 194-202, and 206.**

The examiner asserts that column 8 lines 14-25, column 11 lines 24-30, and column 4 lines 40-49 disclose a "computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product." That assertion is incorrect.

Barnett at column 8 lines 14-25, column 11 lines 24-30, and column 4 lines 40-49 does not disclose a "computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product." Column 8 lines 14-25 in Barnett states that:

The coupon packages file 40 comprises electronic coupon data and other types of advertising materials supplied by the various coupon issuers 14 through the coupon distributor 16. Individual users' coupon data packages are drawn from this file based on demographic data and historic buying profiles stored in the demographic data file 42. Advertisements may consist of graphics, text, recipes, competitions or other inducements or a combination thereof.

This passage does not disclose "incentive offer criteria associated with an identification of a product" because neither "demographic data" nor "historic buying profiles" are product identifications.

The examiner asserts that column 11 lines 24-30 discloses a "incentive offer criteria associated with an identification of a product." That assertion is incorrect. Column 11 lines 24-30 in Barnett states that:

Referring again to FIG. 3, the data format of the variable coupon parameters are set forth and include the coupon expiration date, the redemption amount, the company and product information, the UPC code, the redemption address, and the description of the coupon offer.

This passage does not disclose "incentive offer criteria associated with an identification of a product."

The examiner asserts that column 4 lines 40-49 discloses a "computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product." That assertion is incorrect. Barnett at column 4 lines 40-49 does not disclose a "computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product." Column 4 lines 40-49 in Barnett states that:

In accordance with these and other objects, provided is a system for distributing and generating at a remote site product redemption coupons comprising a centrally located repository of electronically stored product redemption coupon data, transmission means operatively associated with said centrally located repository for providing data communication between said repository and a

plurality of remote user computers, and a remote user computer operatively associated with said transmission means. The remote user computer in the present invention comprises interface means for providing user interaction with the centrally located repository, a memory, and a coupon data management program.

This passage does not disclose "incentive offer criteria associated with an identification of a product." Specifically, it does not disclose a database storing criteria for offering an incentive. Instead, it discloses coupons stored in a database. Therefore, the examiner's assertion that Barnett discloses "incentive offer criteria associated with an identification of a product" is incorrect.

There is no teaching in Barnett suggesting including in a computer system's database incentive offer criteria associated with product identifications. Therefore, Barnett does not suggest a system including a "computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product." Claims 102, 148, 194-202, and 206 recite a "computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product." Therefore, these claims are non-obvious in view of Barnett. Therefore, the rejection of claims 102-148, 194-202, and 206 as obvious over Barnett are improper and should be withdrawn.

**3. The Applicants' Traversal of the Rejections Based On Barnett -
Claims 102, 148, 194, 195, 200-202, and 206**

a. Claims 102, 148, 194, 195, 200-202, and 206 Define a "Kiosk"

Claims 102, 148, 194, 195, 200-202, and 206 define "transmitting a customer's identification from a kiosk to a computer."

b. Barnett Does Not Disclose or Suggest Using a "Kiosk."

i. Barnett, Per Se, Does Not Suggest a Kiosk

Barnett states at col. 6 line 66 to col. 7 line 11:

The online service provider 2 is connected with the data link 4 and is thus accessible by any *remote personal computer 6* having a data communications interface 20 such as a modem (see FIG. 2). The online service provider communicates with the *personal computer 6* in order to transmit requested coupon data, and also in order to receive coupon requests and the user-specific data mentioned above.

The *remote personal computer* 6 has connected thereto a printer 8, which may be any type of computer printer capable of printing graphics. The printer 8 is instructed by the coupon data management routines 32 stored in the computer 6 in order to print printed coupons 18, as will be described in detail below. [Barnett at col. 6 line 66 to col. 7 line 11; emphasis added.]

Applicants' written specification discloses an exemplary embodiment of the "kiosk" recited in the pending claims as follows:

At least one kiosk 26 is placed in each store 14. The kiosk 26 is a *booth or housing*. Preferably, at least one kiosk 26 is located near the entrance of the store 14. One or more additional kiosks can be located in other parts of the store frequented by customers. The system 10 further comprises a customer interface 28 *housed in each kiosk 26* and in communication with the store level computer 12 associated with the store in which the kiosk 26 is located. In the illustrated embodiment, the customer interface comprises a card reader 28 including means for reading the machine readable information on the card, for sending information from the card to the store level computer 12 of the store where the kiosk is located. In the illustrated embodiment, the customer interface comprises a dumb terminal 30 connecting the card reader 28 to the store level computer 12. Other customer interfaces can be employed, such as interactive terminals, touch screen interfaces, etc.

The *kiosk 26 also houses an offer communicator* (offer communicator means) 32 for communicating respective individualized lists of special offers to customers who access the customer interface. While various offer communicators could be employed, in the illustrated embodiment the offer communicator comprises a printer. The printer 32 is preferably a high speed printer, such as a thermal printer, so as to enable quick processing of customers at the kiosk 26 to keep lines at the kiosk 26 down to a minimum. In one embodiment, the printer 32 prints at least 500 lines per minute. More particularly, the printer 32 is a thermal strip printer which prints 600 lines per minute. Other high speed printers can be employed.

The kiosks 26 can also be used by customers to check prices of products. For example, some state laws require that bar code readers be distributed throughout a store so that customers can scan bar codes on products to check prices. The kiosks 26 are capable of being used for this purpose. [Specification page 9 line 17 to page 10 line 23; emphasis added.]

Claims 102, 148, 194, 195, 200-202, and 206 contain "kiosk" or similar recitations. Therefore, the rejections of claims 102, 148, 194, 195, 200-202, and 206 based solely on Spector's disclosed system are improper and should be withdrawn.

ii. **Spector's Kiosk**

Spector (United States Patent 5,176,224) does not explicitly disclose a "kiosk." Instead, Spector shows a structure in FIG. 2 and states at col. 5 lines 52-62 that:

A shopper who wishes to obtain this discount then goes to a discount coupon *printer-dispenser 12*, as shown in FIG. 2, installed at a site in the supermarket that is near the sign. In the example shown, on the front panel of dispenser 12 is a set of three LCD or LED controllable displays which are coupled to an internal microprocessor which in this instance is dedicated to the sign. The microprocessor includes a CPU, ROMS and other computer components and has stored in its memory in digital form, the images of the various items in the supermarket which are subject to discount. [Spector at col. 5 lines 52-62; emphasis added.]

iii. **There Is No Motivation or Suggestion To Modify
Barnett's System Based On Spector's Teachings To
Include a Kiosk**

Spector discloses a "...discount coupon *printer-dispenser 12*, as shown in FIG. 2, installed at a site *in the supermarket...*" [Spector at col. 5 lines 54-55; emphasis added.]

The printer dispenser 12 of Spector (aka kiosk) is designed to be available to many members of the public as they shop in the supermarket. On the other hand, Barnett states at column 6 line 66 to column 7 line 11 that:

The online service provider 2 is connected with the data link 4 and is thus accessible by any *remote personal computer 6* having a data communications interface 20 such as a modem (see FIG. 2). The online service provider communicates with the *personal computer 6* in order to transmit requested coupon data, and also in order to receive coupon requests and the user-specific data mentioned above.

The *remote personal computer 6* has connected thereto a printer 8, which may be any type of computer printer capable of printing graphics. The printer 8 is instructed by the coupon data management routines 32 stored in the computer 6 in order to print printed coupons 18, as will be described in detail below. [Barnett at col. 6 line 66 to col. 7 line 11; emphasis added.]

Moreover, Barnett discloses at column 9 lines 1-33 that user specific files are stored on the user's personal computer, stating at column 9 lines 1-33 that:

The coupon database file 30 is segmented into various sections as shown in the memory map of FIG. 2. The coupon database of the preferred embodiment comprises downloaded coupon data 30a, which is the entire coupon data package

downloaded from the online service provider 2; selected coupon data 30b, which is a subset of the downloaded data and represents specific coupons electronically "clipped" and stored therein; sorted coupon data 30c, which is selected coupon data sorted in accordance with a particular set of criteria (e.g. all fruits together, then all dairy products, etc.); fixed coupon parameters and *user-specific data 30d*, which is certain unvarying data used in printing the coupons as will be described in detail below; and store-specific data 30e, which is information regarding the product arrangement in a certain retail store 10 which will allow the user to prepare a shopping list tailored to the particular store.

The *offline coupon data management routines 32* are executed by the processor 26 in conjunction with the coupon database 30 in order to request, obtain, store, select, sort, and print coupons as desired. The offline coupon data management routines 32 are executed by selecting a desired function button 52, 54, 56, or 58 as shown in the offline display screen 50 in FIG. 4b. The offline display screen 50 is shown on the display 24 when the user runs the coupon data management program on his or her personal computer 6. The *offline coupon data management routines 32 are executed in an offline fashion; that is, the user does not need to first be in online communication with the service provider 2*. If a particular function button 52, 54, 56, or 58 chosen by the user initiates a routine 32 which requires online communication, that routine will initiate, control and terminate an online session with the service provider 2 automatically. [Barnett at col. 9 lines 1-33; emphasis added.]

Barnett requires teaching of storing user specific data files on the user's PC and using offline coupon data management routines both of which would be incompatible with a publically available printer-dispenser, such as Spector's printer-dispenser 12. Since Barnett requires a PC storing personal data files that would be incompatible with a publically available kiosk, Spector provides no motivation to modify the Barnett system to include a printer-dispenser, much less a kiosk. Claims 102, 148, 194, 195, 200-202, and 206 recite "transmitting a customer's identification from a kiosk to a computer." Therefore, the rejections of claims 102, 148, 194, 195, 200-202, and 206 are improper and should be withdrawn.

4. **The Applicants' Traversal of the Rejections Based On Barnett - Claims 102, 148, 194-202, and 206.**

- a. **Claims 102, 148, 194-202, and 206 Define a “computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product.”**

Claims 102, 148, 194-202, and 206 define a computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product.

- b. **Barnett Does Not Disclose or Suggest a “computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product.”**

There is no teaching in Barnett suggesting including in a computer system's database incentive offer criteria associated with product identifications. Therefore, Barnett does not disclose or suggest a system including a “computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product.” Claims 102, 148, 194-202, and 206 recite a “computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product.” Therefore, these claims are non-obvious in view of Barnett. Therefore, the rejection of claims 102-148, 194-202, and 206 are improper and should be withdrawn.

5. **The Applicants' Traversal of the Rejections Based On Barnett - Claim 210.**

- a. **The Examiner's Assertions for Claim 210**

The examiner alleges that Barnett suggests Claim 210, stating in particular that:

Claims 102, 148, 194, 195, 196, 197, 198, 199, 200, 201, 202, 206, 210, 211: Barnett discloses a computer implemented method, system comprising the steps of

transmitting a customer's customer identification from a kiosk to a computer (col 3, lines 35-45; col 4, lines 48-60; col 14, lines 15-30), said computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product and (col 8, lines 14-25;

col 11, lines 24-30; col 4, lines 40-49) (2) containing customer shopping habit data associated with said customer identification (col 8, lines 33-38; col 12, lines 37-63; col 13, lines 24-35);

determining incentive offer criteria satisfied by said customer's customer shopping habit communicating to said kiosk an incentive offer for said product associated with said incentive offer criteria satisfied by said customer's customer shopping habit data (col 9, lines 45-67; col 12, lines 37-63);

inputting at a POS terminal of a retail store a customer identification in association with an identification of an item of a product being purchased by said customer (col 7, lines 35-55; col 4, lines 64-67; Fig. 1); and providing said incentive to said customer when said customer purchases said product at said POS terminal (col 4, lines 64-67; Fig. 1).

Barnett does not explicitly disclose that the personal computer where the coupons are selected can be a kiosk. Barnett does disclose that the coupon obtainment device can be wired or wireless (col 13, lines 35-45; col 6, lines 35-45) and thus flexible as to its location. Barnett further discloses a kiosk where coupons can be selected and obtained (col 3, lines 35-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's coupon selection and obtainment device or computer can be a kiosk. One would have been motivated to do this because a kiosk is a convenient way of obtaining coupons.

Barnett further discloses the step of determining incentive offers for said customer based upon product stock availability (col 10, lines 31-38; col 10, lines 20-25) and that items in stock and coupons can be correlate along with customer shopping habit data (col 10, lines 22-25; col 10, lines 27-30; col 10, lines 44-47).

Barnett further discloses that a supervisor computer can transfer incentive information to a store level computer (Fig. 1). Barnett further discloses displaying at said kiosk for said customer (1) broadcast special offers and (2) offers that depend upon whether said customer's customer shopping habit data meets said incentive offer criteria (col 10, lines 1-30; col 12, lines 37-62).

Barnett further discloses the steps of determining a number of product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria; ranking said product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria;

displaying, based upon said ranking, a predetermined number of the ranked incentive offers at said kiosk to said customer (col 9, lines 15-22; col 10, lines 1-30; col 12, lines 37-62; col 10, lines 1-16). [Office action page 2 lines 13 to page 4 line 22.]

However, the examiner does not specify what teachings of Barnett correspond to claim 210's limitations. Therefore, there is no *prima facie* rejection of claim 210. Therefore, the rejection should be withdrawn.

- b. **Claim 210 Defines "means for sending information from the customized offer list to at least one check-out, means for presenting customized special offers to customers."**

Moreover, claim 210 defines means for sending information from the customized offer list to at least one check-out, means for presenting customized special offers to customers, where the special offers include targeted offers to a customer selected from a plurality of consumers, and means for collecting purchasing behavior.

- c. **Barnett Does Not Teach or Suggest the Structures, Materials, and Acts Disclosed In the Applicants' Specification**

Barnett does not disclose or suggest at least means for sending information from the customized offer list to at least one check-out, means for presenting customized special offers to customers, as shown, for example, in Applicants' FIG. 1. Therefore, Barnett does not disclose or suggest the claimed "at least one computer, means for sending information from the customized offer list to at least one check-out, means for presenting customized special offers to customers, where the special offers include targeted offers to a customer selected from a plurality of consumers, and means for collecting purchasing behavior," as defined by claim 210, when claim 210 is read in light of the Applicants' specification. Therefore, this claims is non-obvious in view of Barnett. Therefore, for this additional reason, the rejection of claim 210 is improper and should be withdrawn.

6. **The Applicants' Traversal of the Rejections Based On Barnett - Claim 211**

a. **The Examiner's Assertions For Claim 211**

The examiner alleges that Barnett suggests Claim 211, stating in particular that:

Claims 102, 148, 194, 195, 196, 197, 198, 199, 200, 201, 202, 206, 210, 211: Barnett discloses a computer implemented method, system comprising the steps of

transmitting a customer's customer identification from a kiosk to a computer (col 3, lines 35-45; col 4, lines 48-60; col 14, lines 15-30), said computer in communication with at least one database (1) containing incentive offer criteria associated with an identification of a product and (col 8, lines 14-25; col 11, lines 24-30; col 4, lines 40-49) (2) containing customer shopping habit data associated with said customer identification (col 8, lines 33-38; col 12, lines

37-63; col 13, lines 24-35);

determining incentive offer criteria satisfied by said customer's customer shopping habit communicating to said kiosk an incentive offer for said product associated with said incentive offer criteria satisfied by said customer's customer shopping habit data (col 9, lines 45-67; col 12, lines 37-63);

inputting at a POS terminal of a retail store a customer identification in association with an identification of an item of a product being purchased by said customer (col 7, lines 35-55; col 4, lines 64-67; Fig. 1); and providing said incentive to said customer when said customer purchases said product at said POS terminal (col 4, lines 64-67; Fig. 1).

Barnett does not explicitly disclose that the personal computer where the coupons are selected can be a kiosk. Barnett does disclose that the coupon obtainment device can be wired or wireless (col 13, lines 35-45; col 6, lines 35-45) and thus flexible as to its location. Barnett further discloses a kiosk where coupons can be selected and obtained (col 3, lines 35-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's coupon selection and obtainment device or computer can be a kiosk. One would have been motivated to do this because a kiosk is a convenient way of obtaining coupons.

Barnett further discloses the step of determining incentive offers for said customer based upon product stock availability (col 10, lines 31-38; col 10, lines 20-25) and that items in stock and coupons can be correlate along with customer shopping habit data (col 10, lines 22-25; col 10, lines 27-30; col 10, lines 44-47).

Barnett further discloses that a supervisor computer can transfer incentive information to a store level computer (Fig. 1). Barnett further discloses displaying at said kiosk for said customer (1) broadcast special offers and (2) offers that depend upon whether said customer's customer shopping habit data meets said incentive offer criteria (col 10, lines 1-30; col 12, lines 37-62).

Barnett further discloses the steps of determining a number of product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria; ranking said product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria;

displaying, based upon said ranking, a predetermined number of the ranked incentive offers at said kiosk to said customer (col 9, lines 15-22; col 10, lines 1-30; col 12, lines 37-62; col 10, lines 1-16). [Office action page 2 lines 13 to page 4 line 22.]

However, the examiner does not specify what teachings of Barnett correspond to claim 211's limitations. Therefore, there is no *prima facie* rejection of claim 211. Therefore, the rejection should be withdrawn.

b. Claim 211 Defines A Supervisory Computer

Moreover, claim 211 defines a supervisory computer, store level computers, a supervisory computer networked to store level computers, where the supervisory computer periodically downloads special offers to the store level computers, means for generating a customized list of special offer available to a particular customer, and means for presenting special offers to customers of a chain of stores.

c. Barnett does Not Teach or Suggest A Supervisory Computer

Barnett does not teach or suggest the claimed "a supervisory computer networked to store level computers, where the supervisory computer periodically downloads special offers to the store level computers," For this reason, the invention defined by claims 211 would not have been obvious to one of ordinary skill in the art in view of the Barnett. Therefore, the rejection of claim 211 is improper and should be withdrawn.

B. Rejections Under 103(a) of Claims 103-107 and 149-153

1. The Examiner's Argument - Kiosk Location

In support of the rejections of claims 103-107, and 149-153 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claims 103, 104, 105, 106, 107, 149-153: Barnett discloses the method, system as in claims 102, 148. Barnett further discloses possessing information on the layout of the store (col 10, lines 30-37). Barnett discloses a kiosk that is separate from the POS terminal (Fig. 1). Barnett does not explicitly disclose the location of the kiosk. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's kiosk can be located in a location that is convenient to the user. The location of the kiosk in or near the store is a design decision which does not affect the method steps performed. One would have been motivated to locate the kiosk at a user convenient location so that the user's coupon obtainment is convenient. [Office action page 4 lines 11-19.]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 103-107 depend from independent claim 102. Claims 149-153 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at

least the reasons given above for claims 102 and 148.

3. Claims 103-105 and 144-151 - At or Near the Store

Claims 103 and 149 define a kiosk located near a retail store, claims 104 and 150 define a kiosk located in a retail store, and claims 105 and 151 define a kiosk located near the entrance to a retail store. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 103-105 and 144-151. Therefore, there is no *prima facie* rejection of claims 103-105 and 144-151. Therefore, the rejections should be withdrawn.

Moreover, the examiner's assertion that relocating the remote personal computer 6 disclosed by Barnett is a "design decision" is not evidence of a suggestion or motivation to modify the teachings Barnett that the personal computer 12's coupon file system is tailored to one user. For this additional reason, the rejections of claims 103-105 and 149-151 are improper and should be withdrawn.

4. Claims 106 and 152 - At Least One Additional Kiosk

The examiner alleges that the cited teachings of Barnett suggest the subject matter defined by claims 106 and 152. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 106 and 152. Therefore, there is no *prima facie* rejection of claims 106 and 152. Therefore, the rejections should be withdrawn.

Moreover, claims 106 and 152 define at least one additional kiosk. The subject matter of claims 106 and 152 finds support in the specification, for example, at page 9 lines 17-20, which states that:

At least one kiosk 26 is placed in each store 14. The kiosk 26 is a booth or housing. Preferably, at least one kiosk 26 is located near the entrance of the store 14. *One or more additional kiosks* can be located in other parts of the store frequented by customers. [Specification at page 9 lines 17-20; emphasis added.]

Barnett teaches no kiosks, much less the claimed "at least one additional kiosk." For this additional reason, the invention defined by claims 106 and 152 would not have been obvious to one of ordinary skill in the art in view of the Barnett. Therefore, the rejections of claims 106 and 152 are improper and should be withdrawn.

5. Claims 107 and 153 - Booth or Housing

The examiner alleges that the cited teachings of Barnett suggest the subject matter

defined by claims 107 and 153. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 107 and 153. Therefore, there is no *prima facie* rejection of claims 107 and 153. Therefore, the rejections should be withdrawn.

Moreover, claims 107 and 153 define a kiosk comprising a booth or housing. Barnett does not disclose or suggest a personal computer including a booth or housing. For this additional reason, the invention defined by claims 107 and 153 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claim 107 and 153 are improper and should be withdrawn.

C. Rejection Under 103(a) of Claims 108-110 and 154-156

1. The Examiner's Argument

In support of the rejections of claims 108-110 and 154-156 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 108, 109, 110, 154, 155, 156: Barnett discloses the method, system according to claim 102, 148. Barnett further discloses the step of reading said customer identification into a customer interface of said kiosk (col 14, lines 16-20; col 14, lines 27-30). Barnett further discloses a dumb terminal and an interactive terminal (col 3, lines 35-45; col 8, lines 51-59).

Barnett does not explicitly disclose that the interface has a touch screen interface. However, Barnett does disclose a kiosk (col 3, lines 35-45) and a computer with an interface with a variety of inputs pointing mechanisms that are standard to computers (col 8, lines 51-59).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's interface with variety of input pointing mechanisms can utilize a touch screen. One would have been motivated to do this because touch screens are standard in the industry and allow a user convenient information input. [Office action page 4 line 20 to page 5 line 9.]

Column 14, lines 16-20 in Barnett states that:

- (b) receiving a request from a user for access to stored coupon information;
- (c) determining if the user is a registered user, and if the user is not registered:
 - i) transmitting a prompt to the remote terminal to electronically complete a user profile and transmit the user profile to the central location;

Column 14, lines 27-30 in Barnett states that:

- iii) downloading to the remote terminal a coupon data management software module for managing the printing of coupons, including unique user identification

information;
if the user is registered, accessing the stored user profile;

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 108-110 depend from independent claim 102. Claims 154-156 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 108-110 and 154-156 - Reading a Customer Identification

The subject matter of claims 108 and 154 finds support in the specification, for example, at page 9 lines 3-16, which states that:

The system 10 further includes a plurality of cards 22. Each card has thereon machine readable information for associating the card with particular customer and customer account, and with a particular store in the chain. In the illustrated embodiment, the card 22 has thereon a UPC code 24. The UPC code identifies the customer and identifies the customer's home store. Every customer has a home store where they set up their account, and where some of their records relating to their purchase behavior are kept. In alternative embodiments, the machine readable information of the card 22 is contained in a magnetic strip, or the card 22 is a smart card. Any other suitable means of storing information in a card can be employed. Similarly, any other means of identifying a customer can be employed instead of the cards and the card readers described below (e.g., passwords, fingerprint scans, retinal scans, etc. are employed in alternative embodiments). [Specification at page 9 lines 3-16.]

Claims 108 and 154 define reading a customer identification into a customer interface of a kiosk. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 108 and 154. Therefore, there is no *prima facie* rejection of claims 108 and 154. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest reading a customer identification into a customer interface of a kiosk. For these additional reasons, the inventions defined by claims 108-110 and 154-156 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 108-110 and 154-156 are

improper and should be withdrawn.

4. Claims 109 and 155 - Dumb Terminal and Interactive Terminal

Claims 109 and 155 define reading a customer identification into a customer interface of a kiosk and a customer interface comprising a member of the set of a dumb terminal and an interactive terminal. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 109 and 155. Therefore, there is no *prima facie* rejection of claims 109 and 155. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest reading a customer identification into a customer interface of a kiosk and a customer interface comprising a member of the set of a dumb terminal and an interactive terminal. For these additional reasons, the inventions defined by claims 109 and 155 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 109 and 155 are improper and should be withdrawn.

5. Claims 110 and 156 - Touch Screen Interface

Claims 110 and 156 define reading a customer identification into a customer interface of a kiosk and a customer interface comprising a touch screen interface. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 110 and 156. Therefore, there is no *prima facie* rejection of claims 110 and 156. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest reading a customer identification into a customer interface of a kiosk and a customer interface comprising a touch screen interface. For these additional reasons, the inventions defined by claims 110 and 156 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 110 and 156 are improper and should be withdrawn.

D. Rejection Under 103(a) of Claims 111-113 and 157-159

1. The Examiner's Argument

In support of the rejections of claims 111-113 and 157-159 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 111, 112, 113, 157-159: Barnett discloses the method, system

according to claim 102, 148. Barnett further discloses communicating to said kiosk an incentive offer for said product comprises printing said incentive offer (col 3, lines 35-40; col 7, lines 5-11). Barnett further discloses that the coupons can be printed at a variety of locations (col 2, lines 64-67; col 3, lines 35-40; col 3, lines 45-50). [Office action page 5 lines 10-20.]

Column 3, lines 35-40 in Barnett states that:

U.S. Pat. No. 5,176,224 to Spector teaches a closed-loop coupon system which consists of a kiosk type printer station located at a retail store. The kiosk is linked to the manufacturers in order to obtain specific coupon information. The consumer selects the desired coupon at the kiosk, and the coupon is printed and dispensed.

Column 7, lines 5-11 in Barnett states that:

The remote personal computer 6 has connected thereto a printer 8, which may be any type of computer printer capable of printing graphics. The printer 8 is instructed by the coupon data management routines 32 stored in the computer 6 in order to print printed coupons 18, as will be described in detail below.

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 111-113 depend from independent claim 102. Claims 157-159 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 111-113 and 157-159 - Printing At a Kiosk

Claims 111 and 157 define communicating to a kiosk an incentive offer for a product comprising printing an incentive offer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 111 and 157. Therefore, there is no *prima facie* rejection of claims 111 and 157. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest communicating to a kiosk an incentive offer for a product comprising printing an incentive offer. For these additional reasons, the inventions defined by claims 111-113 and 157-159 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of

claims 111-113 and 157-159 are improper and should be withdrawn.

4. Claims 112 and 158 - Thermal Printer

Claims 112 and 158 define communicating to a kiosk an incentive offer for a product comprising printing an incentive offer by thermal printing using a thermal printer. Barnett does not disclose or suggest a thermal printer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 112 and 158. Therefore, there is no *prima facie* rejection of claims 112 and 158. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest communicating to a kiosk an incentive offer for a product comprising printing an incentive offer by thermal printing using a thermal printer. For these additional reasons, the inventions defined by claims 112 and 158 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 112 and 158 are improper and should be withdrawn.

5. Claims 113 and 159 - Printing At 500 Lines Per Minute

Claims 113 and 159 define printing comprising communicating to a kiosk an incentive offer for a product comprising printing an incentive offer by printing at a rate of at least 500 lines per minute. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 113 and 159. Therefore, there is no *prima facie* rejection of claims 113 and 159. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest printing comprising communicating to a kiosk an incentive offer for a product comprising printing an incentive offer by printing at a rate of at least 500 lines per minute. For these additional reasons, the inventions defined by claims 113 and 159 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 113 and 159 are improper and should be withdrawn.

E. Rejection Under 103(a) of Claims 114 and 160

1. The Examiner's Argument

In support of the rejections of claims 114 and 160 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 114, 160: Barnett discloses the method, system according to claim

102, 148. Barnett further discloses:

selecting an identification of a product on a kiosk (col 10, lines 1-47), wherein said computer is in communication with a database containing data in association with product identification (col 10, lines 30-47); and transmitting said product's information from said computer to said kiosk (col 10, lines 34-44; col 10, lines 30-47).

Barnett does not explicitly disclose that item information includes item price information.

However, Barnett discloses displaying and organizing product and shopping list item information at the kiosk (col 10, lines 30-47) and that the items can be sorted by a variety of categories (col 10, lines 31-40), and that manufacturers are aware of the prices of their and competitor's items (col 1, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's item information can include price information. One would have been motivated to do this because price information is obvious product item information.

Barnett does not explicitly disclose that the identified product is transmitted from the kiosk to a computer.

However, Barnett discloses transmitting the selected coupon information to the computer directly (col 4, lines 64-67). Barnett further discloses that the shopping list and coupon selection lists can be merged (col 10, lines 28-30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's can transmit his item selection information to the computer from the kiosk when he transmits his coupon selection information. One would have been motivated to do this so that the shopping list can be readily available at the store where the consumer is going to shop in the same way that Barnett discloses that the coupons can be readily available (via electronic transmission) at the store where the consumer is going to shop. [Office action page 5 line 21 to page 7 line 2.]

Column 10 lines 1-47 in Barnett states that:

The coupon file function button 56 enables the user to perform several operations on his selected coupon data file 30b. The user may view the coupons selected (from the selected coupon data file 30b), and may choose any of them for printing. Further, a sortation option is provided which logically sorts, by category and subcategory, the coupons stored. Thus, the management program automatically places all the dairy coupons together, and may also place all the milk coupons together within the dairy category. This is carried out by the coupon sortation routine 32c, and is akin to the manual filing system used in the prior art and will aid the user in viewing his selected but unprinted coupons in an efficient manner. The sorted coupons may be loaded into the sorted coupon data file 30c for subsequent viewing and printing. The user may optionally sort the coupons

manually by his own classification.

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner.

The shopping list generation routine 32g may also advantageously use data stored in the store-specific data file 30e in order to prepare a shopping list tailored to an individual retail store. Thus, data regarding the layout of the store, the food items available at the store, and the like, are used by the list generation routine 32g in order to organize the purchase items accordingly. The data stored in the store-specific data file 30e may be obtained by any of several methods; by downloading from the online service provider 2, by inputting via a floppy disk memory supplied by the store, or even manually input by the user. Data for different stores can be kept in the file 30e and the user simply selects the store he intends on using at that particular time. The user may select a standard pre-programmed shopping list, his last generated shopping list, or a blank shopping list from which to commence his shopping list preparation.

Column 1 lines 50-55 in Barnett states that:

The notion of issuing product redemption coupons to consumers was an innovative idea to entice consumers to try new products in the hope that, after the first try of a new product at a coupon discounted price, they would become repeat customers at the regular price. Coupons are effective tools used in launching new products. [Barnett at column 1 lines 50-55]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 114 depends from independent claim 102. Claim 160 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 114 and 160 - Further Definition Over Barnett

Claims 114 and 160 define transmitting an identification of a product from a kiosk to a

computer, where the computer is in communication with a database containing price data in association with product identification, and transmitting the product's price data from the computer to the kiosk. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 114 and 160. Therefore, there is no *prima facie* rejection of claims 114 and 160. Therefore, the rejections should be withdrawn.

The subject matter of claims 114 and 160 finds support in the specification, for example, at page 10 lines 19-23, which states that:

The kiosks 26 can also be used by customers to check prices of products. For example, some state laws require that *bar code readers* be distributed throughout a store so that customers can *scan bar codes* on products to check prices. The kiosks 26 are capable of being used for this purpose. [Specification at page 10 lines 19-23; emphasis added]

Moreover, Barnett does not disclose or suggest transmitting an identification of a product from a kiosk to a computer, where the computer is in communication with a database containing price data in association with product identification, and transmitting the product's price data from the computer to the kiosk. For these additional reasons, the inventions defined by claims 114 and 160 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 114 and 160 are improper and should be withdrawn.

F. Rejection Under 103(a) of Claims 115 and 161

1. The Examiner's Argument

In support of the rejections of claims 115 and 161 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 115, 161: Barnett discloses the method, system according to claim 114, 148. Barnett does not explicitly disclose displaying product's price data at said kiosk.

However, Barnett discloses displaying product and shopping list item information at the kiosk (col 10, lines 30-47, col 11, lines 24-30) and that the items can be sorted by a variety of categories (col 10, lines 31-40) and that manufacturers are aware of the prices of their and competitor's items (col 1, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's item information can include

price information. One would have been motivated to do this because price information is obvious product item information. [Office action page 7 lines 3-12.]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 115 depends from independent claim 102. Claim 161 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 115 and 161 - Further Definition Over Barnett

Claims 115 and 161 define transmitting an identification of a product from a kiosk to a computer, where the computer is in communication with a database containing price data in association with product identification, and transmitting the product's price data from the computer to the kiosk and displaying a product's price data at a kiosk. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 115 and 161. Therefore, there is no *prima facie* rejection of claims 115 and 161. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest "transmitting an identification of a product from a kiosk to a computer." For this additional reason, the inventions defined by claims 115 and 161 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 115 and 161 are improper and should be withdrawn.

G. Rejection Under 103(a) of Claims 116 and 162

1. The Examiner's Argument

In support of the rejections of claims 116 and 162 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 116, 162: Barnett discloses the method according to claim 102, 148 and further discloses that said POS terminal is spaced apart from said kiosk (Fig. 1). [Office action page 7 lines 13-14.]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 116 depends from independent claim 102. Claim 162 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 116 and 162 - Further Definition Over Barnett

The subject matter of claims 116 and 162 finds support in the specification, for example, at page 9 line 17, which states that "[a]t least one kiosk 26 is placed in each store 14[.]" and at page 11 lines 1-3, which states that:

The system 10 further comprises one or more check-outs or point-of-sale terminals 34 in each store. These are spaced apart from the kiosks 26, which are preferably located in a different area of the store.[Specification page 11 lines 1-3]

Claims 116 and 162 define a POS terminal spaced apart from a kiosk. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 116 and 162. Therefore, there is no *prima facie* rejection of claims 116 and 162. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest define a POS terminal spaced apart from a kiosk. For this additional reason, the inventions defined by claims 116 and 162 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 116 and 162 are improper and should be withdrawn.

H. Rejection Under 103(a) of Claims 117, 118, 163, and 164

1. The Examiner's Argument

In support of the rejections of claims 117, 118, 163, and 164 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 117, 118, 163, 164: Barnett discloses the method, system according to claim 102, 148 and further discloses that said step of inputting comprises reading said customer identification at said POS terminal (col 11, lines 1-25), wherein said step of inputting comprises reading an identification of said product (col 11, lines 1-25; col 11, lines 39-44; col 7, lines 1221). [Office action page 7 lines 16-20]

Column 11 lines 1-25 in Barnett states that:

...coupon printed, redemption instructions, and a user identification bar code number. The user identification bar code number is a unique number assigned to that user, e.g. his social security number or online identification number. This number will be encoded by the printable coupon data generation routine 32d and printed as a bar code 90 on each coupon 18 printed for the particular user. This information will thus be obtained by the coupon redemption center and provided to the coupon distributor 16 for demographic analysis and the like.

The unique user bar code 90 also renders the electronic coupon system of the present invention secure and virtually fraud-proof. Although a user is able to print out a particular coupon 18 only once (to be described in detail below), the coupon issuer 14 could still be defrauded by a user or retailer who might photocopy a printed coupon numerous times and fraudulently and repeatedly present it for redemption. However, in accordance with the present invention, each coupon printed by a user is unique, and the scanning of a coupon presented for redemption will be stored at the coupon redemption center. Thus, the coupon issuer will know if a particular user has redeemed a particular coupon and thus disallow further redemption of a photocopied coupon bearing the same indicia.

Column 11 lines 39-44 in Barnett states that:

The electronic coupon data could also be routed via the data communications interface 20 to a retail store where the user will be shopping, where the coupon data is held in a buffer pending purchase by the user of the matching product.

Column 7 lines 12-21 in Barnett states that:

The printed coupons 18 are used in the normal fashion by a consumer when shopping at a desired retail store 10. That is, the coupons 18 are presented to a product checkout station 11 along with the associated products for purchase, and the discount amount shown on the coupon 18 is credited to the consumer at the point of sale. The redeemed coupons 18 are transmitted to a coupon redemption center 13 where they are electronically read, and user-specific data is stored in a coupon redemption database 12.

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 117 and 118 depend from independent claim 102. Claims 163 and 164 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn

for at least the reasons given above for claims 102 and 148.

3. Claims 117 and 163 - Reading a Customer Identification at a POS Terminal

Claims 117 and 163 define inputting comprising reading a customer identification at a POS terminal. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 117 and 163. Therefore, there is no *prima facie* rejection of claims 117 and 163. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest inputting comprising reading a customer identification at a POS terminal. For this additional reason, the inventions defined by claims 117 and 163 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 117 and 163 are improper and should be withdrawn.

4. Claims 118 and 164 - Reading an Identification of a Product

Claims 118 and 164 define inputting comprising reading an identification of a product. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 118 and 164. Therefore, there is no *prima facie* rejection of claims 118 and 164. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest inputting comprising reading an identification of a product. For this additional reason, the inventions defined by claims 118 and 164 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 118 and 164 are improper and should be withdrawn.

I. Rejection Under 103(a) of Claims 119, 165, and 210

1. The Examiner's Argument

In support of the rejections of claims 119 and 165 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 119, 165: Barnett discloses the method, system according to claim 102, 148 transmitting incentive offer criteria from a supervisory computer to said store computer (col 13, lines 1-10). [Office action page 7 line 21 to page 8 line 2.]

Column 13 lines 1-10 in Barnett states that:

In accordance with the present invention, the marketing analysis, coupon packaging, and coupon package distribution functions carried out by the coupon distributor 16 may be carried out at the central data repository, i.e. Internet web site. Further, the coupon redemption and user redemption information processing functions individually carried out by the coupon redemption center 13 and the individual retail stores 10 may be combined into a single redemption center, as shown by the dotted line in FIG. 1. The physical layout of the functions within the system of the present invention is a matter a practicality and choice of the systems designer and does not impact the utility of the present invention. [Barnett at column 13 lines 1-10]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 119 depends from independent claim 102. Claim 165 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 119 and 165 - A Store Level Computer and Transmitting Incentive Offer Criteria From a Supervisory Computer To the Store Computer

Claims 119 and 165 define a store level computer and transmitting incentive offer criteria from a supervisory computer to the store computer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 119 and 165. Therefore, there is no *prima facie* rejection of claims 119 and 165. Therefore, the rejections should be withdrawn.

Barnett does not disclose or suggest a store level computer and transmitting incentive offer criteria from a supervisory computer to the store computer. For this additional reason, the inventions defined by claims 102 and 148 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 102 and 148 are improper and should be withdrawn.

J. Rejection Under 103(a) of Claims 120, 121, 166, and 167

1. The Examiner's Argument

In support of the rejections of claims 120, 121, 166, and 167 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 120, 121, 166, 167: Barnett discloses the method, system according to claim 102, 148 and further discloses the step of displaying at said kiosk a list of incentive offers for products associated with incentive offer criteria satisfied by said customer's customer shopping habit data, further comprising the step of displaying at said kiosk a list of all incentive offers for products associated with incentive offer criteria satisfied by said customer's customer shopping habit data. (col 10, lines 1-30; col 12, lines 37-62). [Office action page 8 lines 3-8.]

Column 10 lines 1-30 in Barnett states that:

The coupon file function button 56 enables the user to perform several operations on his selected coupon data file 30b. The user may view the coupons selected (from the selected coupon data file 30b), and may choose any of them for printing. Further, a sortation option is provided which logically sorts, by category and subcategory, the coupons stored. Thus, the management program automatically places all the dairy coupons together, and may also place all the milk coupons together within the dairy category. This is carried out by the coupon sortation routine 32c, and is akin to the manual filing system used in the prior art and will aid the user in viewing his selected but unprinted coupons in an efficient manner. The sorted coupons may be loaded into the sorted coupon data file 30c for subsequent viewing and printing. The user may optionally sort the coupons manually by his own classification.

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner. [Barnett at column 10 lines 1-30]

Column 12 lines 37-62 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the

aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 37-62]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 120 and 121 depend from independent claim 102. Claims 166 and 167 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 120 and 166 - Displaying at a Kiosk a List of Incentive Offers for Products Associated with Incentive Offer Criteria Satisfied by a Customer's Customer Shopping Habit Data

Claims 120 and 166 define displaying at a kiosk a list of incentive offers for products associated with incentive offer criteria satisfied by a customer's customer shopping habit data. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 120 and 166. Therefore, there is no *prima facie* rejection of claims 120 and 166. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest displaying at a kiosk a list of incentive offers for products associated with incentive offer criteria satisfied by a customer's customer

shopping habit data. For this additional reason, the inventions defined by claims 120 and 166 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 120 and 166 are improper and should be withdrawn.

4. Claims 121 and 167 - Displaying at a Kiosk a List of All Incentive Offers for Products Associated with Incentive Offer Criteria Satisfied by a Customer's Customer Shopping Habit Data

Claims 121 and 167 define displaying at a kiosk a list of all incentive offers for products associated with incentive offer criteria satisfied by a customer's customer shopping habit data. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 121 and 167. Therefore, there is no *prima facie* rejection of claims 121 and 167. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest displaying at a kiosk a list of all incentive offers for products associated with incentive offer criteria satisfied by a customer's customer shopping habit data. For this additional reason, the inventions defined by claims 121 and 167 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 121 and 167 are improper and should be withdrawn.

K. Rejection Under 103(a) of Claims 122 and 168

1. The Examiner's Argument

In support of the rejections of claims 122 and 168 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 122, 168: Barnett discloses the method, system according to claim 102, 148 and further discloses the step of displaying at said kiosk a list of incentive offers for products (1) associated with incentive offer criteria satisfied by said customer's customer shopping habit data and (2) that meet criteria independent of said customer's shopping habit data (col 10, lines 1-30; col 12, lines 37-62). [Office action page 8 lines 9-13.]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions. Claim 122 depends from independent claim 102. Claim 178 depends from independent claim 148. Therefore, these

rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 122 and 178 - Further Definition Over Barnett

Claims 122 and 178 define displaying at a kiosk a list of incentive offers for products (1) associated with incentive offer criteria satisfied by a customer's customer shopping habit data and (2) that meet criteria independent of a customer's shopping habit data. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 122 and 178. Therefore, there is no *prima facie* rejection of claims 122 and 178. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest displaying at a kiosk a list of incentive offers for products (1) associated with incentive offer criteria satisfied by a customer's customer shopping habit data and (2) that meet criteria independent of a customer's shopping habit data. For this additional reason, the inventions defined by claims 120 and 166 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 120 and 166 are improper and should be withdrawn.

L. Rejection Under 103(a) of Claims 123-125 and 169-171

1. The Examiner's Argument

In support of the rejections of claims 123-125 and 169-171 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 123, 124, 125, 169-171: Barnett discloses the method, system according to claim 102, 148 and further discloses the step of setting a time limit to said incentive offer (col 13, lines 18-20), wherein said time limit is on the order of a few hours, wherein said time limit is about 3 hours (col 13, lines 17-21). Barnett does not explicitly disclose that the time limit can be set to a few hours. However, Barnett discloses that the coupons can be adjusted to better fit certain conditions (col 12, lines 37-63; col 13, lines 24-35). Therefore, it is obvious that the time limit can be set to any favorable amount of time. One would have been motivated to do this so that coupons better incite customers to make immediate or timely purchases. [Office action page 8 lines 14-21.]

Column 13 lines 17-35 in Barnett states that:

In an alternative embodiment of the present invention, the user is provided with a visual or auditory stimulus or cue to suggest an access of the electronic

coupon distribution system. Referring to FIG. 7, a message or logo may be included along with the advertising material normally provided on television, in the newspapers, and the like. This will indicate to a user that he should access the online service provider 2 in order to obtain coupon data related to the advertised product. The availability of the coupon could be time-sensitive, which would provide further incentive to the user to use the system in a prompt and efficient manner. When the radio media is used, a tonal or spoken cue may be included during the advertising message to accomplish the same result.

The amount of redemption discount included with a coupon downloaded to a user may be varied depending on certain demographic information that the system has about the user. For instance, the system may provide a certain value for known users of a brand (which information it will obtain by demographic inquiry or through previous redemptions in the system), and it may provide a higher discount in order to provide an incentive to users of a competitive brand. The ability to vary the value of a discount offer in accordance with such demographic and usage data is a unique advantage offered by the system of the present invention and heretofore unavailable in the prior art. [Barnett at column 13 lines 9-35]

Column 12 lines 37-63 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 37-63]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 123-125 depend from independent claim 102. Claims 169-171 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 123 and 169 - Setting a Time Limit to an Incentive Offer

The subject matter of claims 123-125 and 169-171 finds support in the specification, for example, at page 41 lines 17-22, which states that:

FIG. 20 is a flow chart illustrating deletion of expired special offers. Special offers are valid for a predetermined amount of time after a customer presents a card 22 to the kiosk 26. If the customer does not present the card 22 to the check-out 34 within a predetermined amount of time, the special offers are canceled by the store level computer 12. [Specification at page 41 lines 17-22]

Claims 123 and 169 define setting a time limit to an incentive offer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 123 and 169. Therefore, there is no *prima facie* rejection of claims 123 and 169. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest setting a time limit to an incentive offer. For this additional reason, the inventions defined by claims 123 and 169 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 123 and 169 are improper and should be withdrawn.

4. Claims 124 and 170 - Setting a Time Limit On the Order of a Few Hours

Claims 124 and 170 define a time limit on the order of a few hours. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 124 and 170. Therefore, there is no *prima facie* rejection of claims 124 and 170. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest a time limit on the order of a few hours. For this additional reason, the inventions defined by claims 124 and 170 would not have been

obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 124 and 170 are improper and should be withdrawn.

5. Claims 125 and 177 - Setting a Time Limit of About Three Hours

Claims 125 and 171 define a time limit of about 3 hours. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 125 and 171. Therefore, there is no *prima facie* rejection of claims 125 and 171. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest a time limit of about 3 hours. For this additional reason, the inventions defined by claims 125 and 177 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 125 and 177 are improper and should be withdrawn.

M. Rejection Under 103(a) of Claims 126, 127, 172, and 173

1. The Examiner's Argument

In support of the rejections of claims 126, 127, 172, and 173 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 126, 127, 172, 173: Barnett discloses the method, system according to claim 102, 148, and further discloses the step of determining incentive offers for said customer based upon product stock availability (col 10, lines 31-38; col 10, lines 20-25), further comprising determining incentive offers for said customer based upon a quantity of said customer's customer shopping habit data associated with said customer's customer identification stored in said database (col 10, lines 1-30; col 12, lines 37-62). [Office action page 9 lines 16.]

Column 10 lines 1-46 in Barnett states that:

The coupon file function button 56 enables the user to perform several operations on his selected coupon data file 30b. The user may view the coupons selected (from the selected coupon data file 30b), and may choose any of them for printing. Further, a sortation option is provided which logically sorts, by category and subcategory, the coupons stored. Thus, the management program automatically places all the dairy coupons together, and may also place all the milk coupons together within the dairy category. This is carried out by the coupon sortation routine 32c, and is akin to the manual filing system used in the prior art and will aid the user in viewing his selected but unprinted coupons in an efficient manner. The sorted coupons may be loaded into the sorted coupon data file 30c for subsequent viewing and printing. The user may optionally sort the coupons

manually by his own classification.

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner.

The shopping list generation routine 32g may also advantageously use data stored in the store-specific data file 30e in order to prepare a shopping list tailored to an individual retail store. Thus, data regarding the layout of the store, the food items available at the store, and the like, are used by the list generation routine 32g in order to organize the purchase items accordingly. The data stored in the store-specific data file 30e may be obtained by any of several methods; by downloading from the online service provider 2, by inputting via a floppy disk memory supplied by the store, or even manually input by the user. Data for different stores can be kept in the file 30e and the user simply selects the store he intends on using at that particular time. The user may select a standard pre-programmed shopping list, his last generated shopping list, or a blank shopping list from which to commence his shopping list preparation. [Barnett at column 10 lines 1-46]

Column 12 lines 37-62 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to

packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 37-62]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 126 and 127 depend from independent claim 102. Claims 172 and 173 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 126 and 172 - Determining Incentive Offers for a Customer Based Upon Product Stock Availability

Claims 126 and 172 define determining incentive offers for a customer based upon product stock availability. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 126 and 172. Therefore, there is no *prima facie* rejection of claims 126 and 172. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest determining incentive offers for a customer based upon product stock availability. For this additional reason, the inventions defined by claims 126 and 172 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 126 and 172 are improper and should be withdrawn.

4. Claims 127 and 173 - Determining Incentive Offers for a Customer Based Upon a Quantity of a Customer's Customer Shopping Habit Data Associated with a Customer's Customer Identification Stored in a Database

Claims 127 and 173 define determining incentive offers for a customer based upon a quantity of a customer's customer shopping habit data associated with a customer's customer identification stored in a database. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 127 and 173. Therefore, there is no *prima facie*

rejection of claims 127 and 173. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest determining incentive offers for a customer based upon a quantity of a customer's customer shopping habit data associated with a customer's customer identification stored in a database. For this additional reason, the inventions defined by claims 127 and 173 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 127 and 173 are improper and should be withdrawn.

N. Rejection Under 103(a) of Claims 128 and 174

1. The Examiner's Argument

In support of the rejections of claims 128 and 174 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 128, 174: Barnett discloses the method, system according to claim 102, 148 and further discloses limiting a number of incentive offers communicated to said kiosk for said customer to a predetermined number (col 3, lines 44-52). [Office action page 9 lines 7-9.]

Column 3 lines 44-52 in Barnett states that:

U.S. Pat. No. 4,674,041 to Lemon et al. discloses a system with remotely located coupon printing stations capable of *limiting the number of coupons printed in a given time period*. Each coupon station has a display for indicating the available coupons, selection means to allow the consumer to choose the desired coupon, and a coupon printer. The system disables display of a particular coupon when a preselected coupon limit has been reached. [Barnett at column 3 lines 44-52; emphasis added.]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 128 depends from independent claim 102. Claim 174 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 128 and 174 - Further Definition Over Barnett

Claims 128 and 174 define limiting a number of incentive offers communicated to a

kiosk for a customer to a predetermined number. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 128 and 174. Therefore, there is no *prima facie* rejection of claims 128 and 174. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest limiting a number of incentive offers communicated to a kiosk for a customer to a predetermined number. For these additional reasons, the inventions defined by claims 128 and 174 would not have been obvious to one of ordinary skill in the art in view of the Barnett, Spector, and Lemon et al. patents. Therefore, the rejections of claims 128 and 174 are improper and should be withdrawn.

O. Rejection Under 103(a) of Claims 129 and 175

1. The Examiner's Argument

In support of the rejections of claims 129 and 175 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 129, 175 : Barnett discloses the method, system according to claim 102, 148 and further discloses displaying at said kiosk for said customer (1) broadcast special offers and (2) offers that depend upon whether said customer's customer shopping habit data meets said incentive offer criteria (col 10, lines 1-30; col 12, lines 37-62). [Office action page 9 lines 10-14.]

Column 10 lines 1-30 in Barnett states that:

The coupon file function button 56 enables the user to perform several operations on his selected coupon data file 30b. The user may view the coupons selected (from the selected coupon data file 30b), and may choose any of them for printing. Further, a sortation option is provided which logically sorts, by category and subcategory, the coupons stored. Thus, the management program automatically places all the dairy coupons together, and may also place all the milk coupons together within the dairy category. This is carried out by the coupon sortation routine 32c, and is akin to the manual filing system used in the prior art and will aid the user in viewing his selected but unprinted coupons in an efficient manner. The sorted coupons may be loaded into the sorted coupon data file 30c for subsequent viewing and printing. The user may optionally sort the coupons manually by his own classification.

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons

along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner. [Barnett at column 10 lines 1-30]

Column 12 lines 37-62 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 37-62]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 129 depends from independent claim 102. Claim 175 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 129 and 175 - Further Definition Over Barnett

The subject matter of claims 129 and 175 finds support in the specification, for example, at page 12 lines 1-7, which states that:

The first few times the customer uses the card 22, the computer 12 will have little information about the customer's buying habits. Therefore, the special offers available to the customer may not contain many targeted special offers. To keep the customer interested in using the card, while purchasing behavior information is being obtained, the customer will be given *broadcast special offers, which are special offers available to everyone* (as opposed to targeted special offers). [Specification at page 12 lines 1-7; emphasis added.]

Claims 129 and 175 define displaying at a kiosk for a customer (1) broadcast special offers and (2) offers that depend upon whether a customer's customer shopping habit data meets a incentive offer criteria. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 129 and 175. Therefore, there is no *prima facie* rejection of claims 129 and 175. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest displaying at a kiosk for a customer (1) broadcast special offers and (2) offers that depend upon whether a customer's customer shopping habit data meets a incentive offer criteria. For this additional reason, the inventions defined by claims 129 and 175 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 129 and 175 are improper and should be withdrawn.

P. Rejection Under 103(a) of Claims 130 and 176

1. The Examiner's Argument

In support of the rejections of claims 130 and 176 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 130, 176: Barnett discloses the method, system according to claim 102, 148 and further discloses displaying at said kiosk for said customer broadcast special offers to said customer only if less than a predetermined quantity of customer shopping habit data associated with said customer identification is stored in said database (col 9, lines 1-33; col 10, lines 1-30; col 12, lines 37-62). [Office action page 9 lines 14-18.]

Column 9 lines 1-33 in Barnett states that:

The coupon database file 30 is segmented into various sections as shown in the memory map of FIG. 2. The coupon database of the preferred embodiment comprises downloaded coupon data 30a, which is the entire coupon data package downloaded from the online service provider 2; selected coupon data 30b, which

is a subset of the downloaded data and represents specific coupons electronically "clipped" and stored therein; sorted coupon data 30c, which is selected coupon data sorted in accordance with a particular set of criteria (e.g. all fruits together, then all dairy products, etc.); fixed coupon parameters and user-specific data 30d, which is certain unvarying data used in printing the coupons as will be described in detail below; and store-specific data 30e, which is information regarding the product arrangement in a certain retail store 10 which will allow the user to prepare a shopping list tailored to the particular store.

The offline coupon data management routines 32 are executed by the processor 26 in conjunction with the coupon database 30 in order to request, obtain, store, select, sort, and print coupons as desired. The offline coupon data management routines 32 are executed by selecting a desired function button 52, 54, 56, or 58 as shown in the offline display screen 50 in FIG. 4b. The offline display screen 50 is shown on the display 24 when the user runs the coupon data management program on his or her personal computer 6. The offline coupon data management routines 32 are executed in an offline fashion; that is, the user does not need to first be in online communication with the service provider 2. If a particular function button 52, 54, 56, or 58 chosen by the user initiates a routine 32 which requires online communication, that routine will initiate, control and terminate an online session with the service provider 2 automatically. [Barnett at column 9 lines 1-33]

Column 10 lines 1-30 in Barnett states that:

The coupon file function button 56 enables the user to perform several operations on his selected coupon data file 30b. The user may view the coupons selected (from the selected coupon data file 30b), and may choose any of them for printing. Further, a sortation option is provided which logically sorts, by category and subcategory, the coupons stored. Thus, the management program automatically places all the dairy coupons together, and may also place all the milk coupons together within the dairy category. This is carried out by the coupon sortation routine 32c, and is akin to the manual filing system used in the prior art and will aid the user in viewing his selected but unprinted coupons in an efficient manner. The sorted coupons may be loaded into the sorted coupon data file 30c for subsequent viewing and printing. The user may optionally sort the coupons manually by his own classification.

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the

shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner.
[Barnett at column 10 lines 1-30]

Column 12 lines 37-62 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 37-62]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 130 depends from independent claim 102. Claim 176 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 130 and 176 - Further Definition Over Barnett

Claims 130 and 176 define displaying at a kiosk for said customer broadcast special offers to a customer only if less than a predetermined quantity of customer shopping habit data associated with a customer identification is stored in a database. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 130 and 176.

Therefore, there is no *prima facie* rejection of claims 130 and 176. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest displaying at a kiosk for said customer broadcast special offers to a customer only if less than a predetermined quantity of customer shopping habit data associated with a customer identification is stored in a database. For this additional reason, the inventions defined by claims 130 and 176 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 130 and 176 are improper and should be withdrawn.

Q. Rejection Under 103(a) of Claims 131 and 177

1. The Examiner's Argument

In support of the rejections of claims 131 and 177 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 131, 177: Barnett discloses the method, system according to claim 122, 148 and further discloses the steps of determining a number of product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria;

ranking said product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria;

displaying, based upon said ranking, a predetermined number of the ranked incentive offers at said kiosk to said customer (col 9, lines 15-22; col 10, lines 1-30; col 12, lines 37-62; col 10, lines 1-16). [Office action page 9 line 20 to page 10 line 5.]

Column 9 lines 15-22 in Barnett states that:

The offline coupon data management routines 32 are executed by the processor 26 in conjunction with the coupon database 30 in order to request, obtain, store, select, sort, and print coupons as desired. The offline coupon data management routines 32 are executed by selecting a desired function button 52, 54, 56, or 58 as shown in the offline display screen 50 in FIG. 4b. [Barnett at column 9 lines 15-22]

Column 10 lines 1-30 in Barnett states that:

The coupon file function button 56 enables the user to perform several operations on his selected coupon data file 30b. The user may view the coupons selected (from the selected coupon data file 30b), and may choose any of them for printing. Further, a sortation option is provided which logically sorts, by category

and subcategory, the coupons stored. Thus, the management program automatically places all the dairy coupons together, and may also place all the milk coupons together within the dairy category. This is carried out by the coupon sortation routine 32c, and is akin to the manual filing system used in the prior art and will aid the user in viewing his selected but unprinted coupons in an efficient manner. The sorted coupons may be loaded into the sorted coupon data file 30c for subsequent viewing and printing. The user may optionally sort the coupons manually by his own classification.

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner. [Barnett at column 10 lines 1-30]

Column 12 lines 37-62 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. [Barnett at column 12 lines 37-62]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 131 depends from independent claim 102. Claim 177 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 131 and 177 - Further Definition Over Barnett

The subject matter of claims 131 and 177 finds support in the specification, for example, at page 18 lines 11-14, which states that:

...Because the store level computers maintain records of purchase behavior, the supervisory computer 16 is capable of printing out reports of whether targeted special offers were accepted, and *with what degree of success*. [Specification at page 18 lines 11-14; emphasis added.]

Claims 131 and 177 define determining a number of product incentive offers for which a customer's shopping habit data satisfies an incentive offer criteria, ranking a product incentive offers for which a customer's shopping habit data satisfies an incentive offer criteria, and displaying, based upon the ranking, a predetermined number of the ranked incentive offers at the kiosk to the customer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 131 and 177. Therefore, there is no *prima facie* rejection of claims 131 and 177. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest determining a number of product incentive offers for which a customer's shopping habit data satisfies an incentive offer criteria, ranking a product incentive offers for which a customer's shopping habit data satisfies an incentive offer criteria, and displaying, based upon the ranking, a predetermined number of the ranked incentive offers at the kiosk to the customer. For this additional reason, the inventions defined by claims 131 and 177 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 131 and 177 are improper and should be withdrawn.

R. Rejection Under 103(a) of Claims 132-134, 178-180, 203-205, and 207-209

1. The Examiner's Argument

In support of the rejections of claims 132-134, 178-180, 203-205, and 207-209 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 132, 133, 134, 178-180, 203-205, 207-209: Barnett discloses the method, system according to claim 131, 177, 202, 206. Barnett further discloses storing the value of incentives and that the incentives can be sorted by a variety of categories (col 10, lines 1-16; col 11, lines 24-30). Barnett further discloses that product information can be stored on the coupon (col 11, lines 24-30), that the product information comprises whether an item is available (col 10, lines 34-37), and that all forms of information about a store can be downloaded (col 10, lines 38-46) and that information about the items selected can be downloaded (col 10, lines 27-30; col 10, lines 34-36).

Barnett does not explicitly disclose that item information includes item

price information.

However, Barnett discloses displaying and organizing product and shopping list item information at the kiosk (col 10, lines 30-47) and that the items can be sorted by a variety of categories (col 10, lines 31-40), and that manufacturers are aware of the prices of their and competitor's items (col 1, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's item information can include price information. One would have been motivated to do this because price information is obvious product item information.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Barnett can rank the incentives by the product information contained in the shopping list. One would have been motivated to do this so that the customer can organize his coupons how he prefers. [Office action page 10 line 6 to page 11 line 4.]

Column 10 lines 1-47 in Barnett states that:

The coupon file function button 56 enables the user to perform several operations on his selected coupon data file 30b. The user may view the coupons selected (from the selected coupon data file 30b), and may choose any of them for printing. Further, a sortation option is provided which logically sorts, by category and subcategory, the coupons stored. Thus, the management program automatically places all the dairy coupons together, and may also place all the milk coupons together within the dairy category. This is carried out by the coupon sortation routine 32c, and is akin to the manual filing system used in the prior art and will aid the user in viewing his selected but unprinted coupons in an efficient manner. The sorted coupons may be loaded into the sorted coupon data file 30c for subsequent viewing and printing. The user may optionally sort the coupons manually by his own classification.

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner.

The shopping list generation routine 32g may also advantageously use data stored in the store-specific data file 30e in order to prepare a shopping list tailored to an individual retail store. Thus, data regarding the layout of the store, the food items available at the store, and the like, are used by the list generation routine

32g in order to organize the purchase items accordingly. The data stored in the store-specific data file 30e may be obtained by any of several methods; by downloading from the online service provider 2, by inputting via a floppy disk memory supplied by the store, or even manually input by the user. Data for different stores can be kept in the file 30e and the user simply selects the store he intends on using at that particular time. The user may select a standard pre-programmed shopping list, his last generated shopping list, or a blank shopping list from which to commence his shopping list preparation. [Barnett at column 10 lines 1-47]

Column 11 lines 24-30 in Barnett states that:

Referring again to FIG. 3, the data format of the variable coupon parameters are set forth and include the coupon expiration date, the redemption amount, the company and product information, the UPC code, the redemption address, and the description of the coupon offer. [Barnett at column 11 lines 24-30]

Column 1 lines 50-55 in Barnett states that:

The notion of issuing product redemption coupons to consumers was an innovative idea to entice consumers to try new products in the hope that, after the first try of a new product at a coupon discounted price, they would become repeat customers at the regular price. Coupons are effective tools used in launching new products. [Barnett at column 1 lines 50-55]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 132-134 depend from independent claim 102. Claims 178-180 depend from independent claim 148. Claims 203-205 depend from independent claim 201. Claims 207-209 depend from independent claim 206. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102, 148, 201, and 206.

3. Claims 132, 178, 203, and 207 - Ranking Depending Upon Value of an Incentive

Claims 132, 178, 203, and 207 define ranking depending upon value of an incentive. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 132, 178, 203, and 207. Therefore, there is no *prima facie* rejection of claims 132, 178,

203, and 207. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest ranking depending upon value of an incentive. For this additional reason, the inventions defined by claims 132, 178, 203, and 207 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 132, 178, 203, and 207 are improper and should be withdrawn.

4. Claims 133, 179, 204, and 208 - Ranking Depending Upon Price of a Product

Claims 133, 179, 204, and 208 define ranking depending upon price of a product. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 133, 179, 204, and 208. Therefore, there is no *prima facie* rejection of claims 133, 179, 204, and 208. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest ranking depending upon price of a product. For this additional reason, the inventions defined by claims 133, 179, 204, and 208 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 133, 179, 204, and 208 are improper and should be withdrawn.

5. Claims 134, 180, 205, and 209 - Ranking Depending Upon a Stock Condition

Claims 134, 180, 205, and 209 define ranking depending upon a stock condition. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 134, 180, 205, and 209. Therefore, there is no *prima facie* rejection of claims 134, 180, 205, and 209. Therefore, the rejections should be withdrawn.

Barnett does not disclose or suggest ranking depending upon a stock condition. For this additional reason, the inventions defined by claims 134, 180, 205, and 209 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 134, 180, 205, and 209 are improper and should be withdrawn.

S. Rejection Under 103(a) of Claims 135 and 181

1. The Examiner's Argument

In support of the rejections of claims 135 and 181 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 135, 181: Barnett discloses the method, system according to claim 102, 148 and further discloses the steps of determining a number of product incentive offers for which said customer's shopping habit data satisfies said incentive offer criteria; providing at said kiosk a first predetermined number of said incentive offers to said customer; and providing at said kiosk a second predetermined number of broadcast incentive offers to said customer (col 9, lines 15-22; col 10, lines 1-30; col 12, lines 37-62; col 10, lines 1-16). [Office action page 11 lines 5-10.]

Column 9 lines 15-22 in Barnett states that:

The offline coupon data management routines 32 are executed by the processor 26 in conjunction with the coupon database 30 in order to request, obtain, store, select, sort, and print coupons as desired. The offline coupon data management routines 32 are executed by selecting a desired function button 52, 54, 56, or 58 as shown in the offline display screen 50 in FIG. 4b. [Barnett at column 9 lines 15-22]

Column 10 lines 1-30 in Barnett states that:

The coupon file function button 56 enables the user to perform several operations on his selected coupon data file 30b. The user may view the coupons selected (from the selected coupon data file 30b), and may choose any of them for printing. Further, a sortation option is provided which logically sorts, by category and subcategory, the coupons stored. Thus, the management program automatically places all the dairy coupons together, and may also place all the milk coupons together within the dairy category. This is carried out by the coupon sortation routine 32c, and is akin to the manual filing system used in the prior art and will aid the user in viewing his selected but unprinted coupons in an efficient manner. The sorted coupons may be loaded into the sorted coupon data file 30c for subsequent viewing and printing. The user may optionally sort the coupons manually by his own classification.

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons

along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner.

[Barnett at column 10 lines 1-30]

Column 12 lines 37-62 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 37-62]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 135 depends from independent claim 102. Claim 181 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 135 and 181 - Further Definition Over Barnett

Claims 135 and 181 define determining a number of product incentive offers for which a customer's shopping habit data satisfies a incentive offer criteria, providing at a kiosk a first

predetermined number of incentive offers to the customer, and providing at the kiosk a second predetermined number of broadcast incentive offers to the customer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 135 and 181. Therefore, there is no *prima facie* rejection of claims 135 and 181. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest determining a number of product incentive offers for which a customer's shopping habit data satisfies a incentive offer criteria, providing at a kiosk a first predetermined number of incentive offers to the customer, and providing at the kiosk a second predetermined number of broadcast incentive offers to the customer. For this additional reason, the inventions defined by claims 135 and 181 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 135 and 181 are improper and should be withdrawn.

T. Rejection Under 103(a) of Claims 136, 137, 182, and 183

1. The Examiner's Argument

In support of the rejections of claims 136, 137, 182, and 183 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 136, 137, 182, 183: Barnett discloses the method, system according to claim 102, 148 and further discloses the step of downloading to said POS terminal a list containing identifications of all products for which incentive offer criteria associated with an identification of a product are stored in said database (col 9, lines 15-22; col 10, lines 1-30; col 12, lines 37-62; col 10, lines 1-16), further comprising the step of downloading to said POS terminal a list containing identifications of all products for which incentive offers are available to said customer (col 9, lines 15-22; col 10, lines 1-30; col 12, lines 37-62; col 10, lines 1-16). [Office action page 11 lines 12-18.]

Column 9 lines 15-22 in Barnett states that:

The offline coupon data management routines 32 are executed by the processor 26 in conjunction with the coupon database 30 in order to request, obtain, store, select, sort, and print coupons as desired. The offline coupon data management routines 32 are executed by selecting a desired function button 52, 54, 56, or 58 as shown in the offline display screen 50 in FIG. 4b. [Barnett at column 9 lines 15-22]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 136 and 137 depend from independent claim 102. Claims 182 and 183 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 136 and 182 - Downloading to a POS Terminal a List Containing Identifications of All Products for which Incentive Offer Criteria Associated with an Identification of a Product Are Stored In a Database

Claims 136 and 182 define downloading to a POS terminal a list containing identifications of all products for which incentive offer criteria associated with an identification of a product are stored in a database. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 136 and 182. Therefore, there is no *prima facie* rejection of claims 136 and 182. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest downloading to a POS terminal a list containing identifications of all products for which incentive offer criteria associated with an identification of a product are stored in a database. For this additional reason, the inventions defined by claims 136 and 182 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 136 and 182 are improper and should be withdrawn.

4. Claims 137 and 183 - Downloading to a POS Terminal a List Containing Identifications of All Products for which Incentive Offer Are Available To a Customer

Claims 137 and 183 define downloading to a POS terminal a list containing identifications of all products for which incentive offers are available to a customer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 137 and 183. Therefore, there is no *prima facie* rejection of claims 137 and 183. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest downloading to a POS terminal a list containing identifications of all products for which incentive offers are available to a customer. For this additional reason, the inventions defined by claims 137 and 183 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 137 and 182 are improper and should be withdrawn.

U. Rejection Under 103(a) of Claims 138-140 and 184-186

1. The Examiner's Argument

In support of the rejections of claims 138-140 and 184-186 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 138, 139, 140, 184-186: Barnett discloses the method, system according to claim 102, 148 and further discloses that customer shopping habit data comprises incentive receipt data for said customer's receipt of incentives, wherein said customer shopping habit data comprises a quantity of incentive offers for a product provided to said customer (col 11, lines 17-30; col 12 lines 37-62), wherein said customer shopping habit data is associated with an indication of a household associated with said customer (col 6, lines 49-51; col 12, lines 40-45). [Office action page 11 line 19 to page 12 line 2.]

Column 11 lines 17-30 in Barnett states that:

...However, in accordance with the present invention, each coupon printed by a user is unique, and the scanning of a coupon presented for redemption will be stored at the coupon redemption center. Thus, the coupon issuer will know if a particular user has redeemed a particular coupon and thus disallow further redemption of a photocopied coupon bearing the same indicia.

Referring again to FIG. 3, the data format of the variable coupon parameters are set forth and include the coupon expiration date, the redemption amount, the company and product information, the UPC code, the redemption address, and the description of the coupon offer. [Barnett at column 11 lines 17-30]

Column 12 lines 37-62 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of

Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 37-62]

Column 6 lines 49-61 in Barnett states that:

...Thus, any centrally located computer system which is accessible to the public by any transmission means is contemplated as being within the scope of this invention. As used herein, the term "user" denotes an individual user or a household of users linked through one account.

The online service provider has stored in its database 40 (see FIGS. 6 and 10) various packages of electronic coupon data, the content of which will be further described below. The electronic coupon data is provided, by a coupon distributor 16 or coupon issuer 14, by any of various means such as electronic transmission via the PSTN or satellite data exchange. The online service provider also stores in a demographic data file 42 user-specific data, including coupons selected data, coupons deleted data, coupons printed data and user demographics, as will be described below, for subsequent transmission to a coupon distributor 16. [Barnett at column 6 lines 49-61]

Column 12 lines 40-45 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. [Barnett at column 12 lines 40-45]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 138-140 depend from independent claim 102. Claims 184-186 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 138 and 184 - Customer Shopping Habit Data Comprising Incentive Receipt Data for a Customer's Receipt of Incentives

The subject matter of claims 138-140 and 184-186 finds support in the specification, for example, at page 14 line 13 to page 15 line 10, which states that:

...If or when the customer card 22 is finally scanned at the check-out register 34 as part of the shopping trip, the check-out 34 communicates the card number of the customer card 22 to the store level computer 12. The store level computer 12 then communicates to the check-out register 34 each discount that the consumer qualified for because of the product purchases made in this shopping trip prior to the scan of the customer card 22. Subsequent discounts are then received by the check-out 34 immediately following the scan of a qualifying product, as previously presented.

Special offers that were accepted by the customer, and that are restricted to a certain quantity of product, will not be available to the customer the next time the customer accesses the kiosk 26 if the quantity limit has been reached. Thus, double couponing (where a customer uses the same coupon in different stores to avoid quantity limits) is avoided. The check-out sends to the computer 12 information regarding all purchases made by the customer.

Optionally, members of a household could be treated a single customer, so that they can take advantage of combined purchasing power. The members of the household would then have cards associating them with the same customer account in the computer 12. The computer 12 identifies which customers should be treated as a household, such as if two customers have the same address.

[Specification at page 14 line 13 to page 15 line 10]

Claims 138 and 184 define customer shopping habit data comprising incentive receipt data for a customer's receipt of incentives. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 138 and 184. Therefore, there is no *prima facie* rejection of claims 138 and 184. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest customer shopping habit data comprising

incentive receipt data for a customer's receipt of incentives. There is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed customer shopping habit data comprising incentive receipt data for a customer's receipt of incentives, as defined by claims 138 and 184. For this additional reason, the inventions defined by claims 138 and 184 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 138 and 184 are improper and should be withdrawn.

4. Claims 139 and 185 - Customer Shopping Habit Data Comprising a Quantity of Incentive Offers for a Product Provided To a Customer

Claims 139 and 185 define customer shopping habit data comprising a quantity of incentive offers for a product provided to a customer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 139 and 185. Therefore, there is no *prima facie* rejection of claims 139 and 185. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest customer shopping habit data comprising a quantity of incentive offers for a product provided to a customer. There is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed customer shopping habit data comprising a quantity of incentive offers for a product provided to a customer, as defined by claims 139 and 185. For this additional reason, the inventions defined by claims 139 and 185 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 139 and 185 are improper and should be withdrawn.

5. Claims 140 and 186 - Customer Shopping Habit Data Associated With an Indication of a Household Associated With a Customer

Claims 140 and 186 define customer shopping habit data associated with an indication of a household associated with a customer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 140 and 186. Therefore, there is no *prima facie* rejection of claims 140 and 186. Therefore, the rejections should be withdrawn.

Moreover, Barnett does not disclose or suggest customer shopping habit data associated with an indication of a household associated with a customer. There is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed customer shopping habit data

associated with an indication of a household associated with a customer, as defined by claims 140 and 186. For this additional reason, the inventions defined by claims 140 and 186 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 140 and 186 are improper and should be withdrawn.

V. Rejection Under 103(a) of Claims 141 and 187

1. The Examiner's Argument

In support of the rejections of claims 141 and 187 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 141, 187: Barnett discloses the method, system according to claim 140, 186 and further discloses the step of providing the customer means to opt out of having incentive offer criteria being based upon household identification (col 6, lines 49-51). Barnett discloses that the incentives can be targeted to an individual user, therefore, it is inherent that the user can select whether to offer only an individual user information or household information. [Office action page 12 lines 3-7.]

Column 6 lines 49-51 in Barnett states that:

...As used herein, the term "user" denotes an individual user or a household of users linked through one account. [Barnett at column 6 lines 49-51]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 141 depends from independent claim 102. Claim 187 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 141 and 187 - Further Definition Over Barnett

Claims 141 and 187 define providing the customer means to opt out of having incentive offer criteria being based upon household identification. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 141 and 187. Therefore, there is no *prima facie* rejection of claims 141 and 187. Therefore, the rejections should be withdrawn.

Moreover, there is no teaching or suggestion in the cited disclosure of Barnett that

enables the claimed providing the customer means to opt out of having incentive offer criteria being based upon household identification, as defined by claims 141 and 187. For this additional reason, the inventions defined by claims 141 and 187 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 141 and 187 are improper and should be withdrawn.

W. Rejection Under 103(a) of Claims 142 and 188

1. The Examiner's Argument

In support of the rejections of claims 142 and 188 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 142, 188: Barnett discloses the method, system according to claim 102, 148 and further discloses that said incentive offer criteria associated with an identification of a product comprises a time after which said incentive offer is no longer available (col 13, lines 17-21). [Office action page 12 lines 8-10.]

Column 3 lines 17-21 in Barnett states that:

U.S. Pat. Nos. 5,285,278 and 5,287,181 to Holman also teach a television-based coupon reception system. Coupon information is encoded into a television broadcast signal and decoded at the consumer's television by circuitry similar to that used for closed-caption broadcast decoding. [Barnett at column 3 lines 17-21]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 142 depends from independent claim 102. Claim 188 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 142 and 188 - Further Definition Over Barnett

Claims 142 and 188 define incentive offer criteria associated with an identification of a product comprising a time after which said incentive offer is no longer available. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 142 and 188. Therefore, there is no *prima facie* rejection of claims 142 and 188. Therefore, the rejections should be withdrawn.

Moreover, there is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed incentive offer criteria associated with an identification of a product comprising a time after which said incentive offer is no longer available, as defined by claims 142 and 188. For this additional reason, the inventions defined by claims 142 and 188 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 142 and 188 are improper and should be withdrawn.

X. Rejection Under 103(a) of Claims 143 and 189

1. The Examiner's Argument

In support of the rejections of claims 143 and 189 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 143, 189: Barnett discloses the method, system according to claim 102, 148 and further discloses the steps of classifying products by category (col 10, lines 17-46) and that item and manufacturer information can be tracked (col 10, lines 34-46; col 11, lines 26-30). Barnett further discloses that coupon packages can be assembled and varied based on a wide variety of criteria limiting incentive offers for products in a category to one manufacturer (col 12, lines 37-62).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's category information can include manufacturer as a category. One would have been motivated to do this because manufacturer is an obvious piece of item information.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's wide variety of coupon packages can include from just one manufacturer in one category. One would have been motivated to do this to encourage the user to try a new or different brand (col 1, lines 50-55). [Office action page 12 line 11 to page 13 line 2.]

Column 10 lines 17-46 in Barnett states that:

The shopping list function button 58 calls the shopping list generation routine 32g when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase, and the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database 30 and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner.

The shopping list generation routine 32g may also advantageously use data stored in the store-specific data file 30e in order to prepare a shopping list tailored to an individual retail store. Thus, data regarding the layout of the store, the food items available at the store, and the like, are used by the list generation routine 32g in order to organize the purchase items accordingly. The data stored in the store-specific data file 30e may be obtained by any of several methods; by downloading from the online service provider 2, by inputting via a floppy disk memory supplied by the store, or even manually input by the user. Data for different stores can be kept in the file 30e and the user simply selects the store he intends on using at that particular time. The user may select a standard pre-programmed shopping list, his last generated shopping list, or a blank shopping list from which to commence his shopping list preparation. [Barnett at column 10 lines 17-46]

Column 11 lines 26-30 in Barnett states that:

Referring again to FIG. 3, the data format of the variable coupon parameters are set forth and include the coupon expiration date, the redemption amount, the company and product information, the UPC code, the redemption address, and the description of the coupon offer. [Barnett at column 11 lines 26-30]

Column 12 lines 37-42 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. [Barnett at column 12 lines 37-42]

Column 1 lines 50-55 in Barnett states that:

The notion of issuing product redemption coupons to consumers was an innovative idea to entice consumers to try new products in the hope that, after the first try of a new product at a coupon discounted price, they would become repeat customers at the regular price. Coupons are effective tools used in launching new products. [Barnett at column 1 lines 50-55]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 143 depends from independent claim 102. Claim 189 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 143 and 189 - Further Definition Over Barnett

Claims 143 and 189 define classifying products by category and manufacturer, and limiting incentive offers for products in a category to one manufacturer. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 143 and 189. Therefore, there is no *prima facie* rejection of claims 143 and 189. Therefore, the rejections should be withdrawn.

Moreover, there is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed classifying products by category and manufacturer, and limiting incentive offers for products in a category to one manufacturer, as defined by claims 143 and 189. For this additional reason, the inventions defined by claims 143 and 189 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 143 and 189 are improper and should be withdrawn.

Y. Rejection Under 103(a) of Claims 144 and 190

1. The Examiner's Argument

In support of the rejections of claims 144 and 190 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 144, 190: Barnett discloses the method, system according to claim 102, 148. Barnett further discloses that user shopping habits at a store can be tracked and recorded (col 10, lines 3 5-47), that the location of processes and computers can be flexibly placed (col 13, lines 110; Fig. 1), that consumer demographics, habits, and history can be tracked and analyzed (col 12, lines 37-63), that the customer selects a specific store when he creates a shopping list (col 10, lines 42-45).

Barnett does not explicitly disclose that the shopping list information is transmitted from the kiosk to the computer.

However, Barnett discloses transmitting the selected coupon information to the computer directly (col 4, lines 64-67). Barnett further discloses that the shopping list and coupon selection lists can be merged (col 10, lines 28-30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's can transmit his item selection information to the computer from the kiosk when he transmits his

coupon selection information. One would have been motivated to do this so that the shopping list information can be readily available at the store where the consumer is going to shop in the same way that Barnett discloses that the coupons can be readily available (via electronic transmission) at the store where the consumer is going to shop. [Office action page 13 lines 3-20.]

Column 10 lines 28-47 in Barnett states that:

...Thus, in either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner.

The shopping list generation routine 32g may also advantageously use data stored in the store-specific data file 30e in order to prepare a shopping list tailored to an individual retail store. Thus, data regarding the layout of the store, the food items available at the store, and the like, are used by the list generation routine 32g in order to organize the purchase items accordingly. The data stored in the store-specific data file 30e may be obtained by any of several methods; by downloading from the online service provider 2, by inputting via a floppy disk memory supplied by the store, or even manually input by the user. Data for different stores can be kept in the file 30e and the user simply selects the store he intends on using at that particular time. The user may select a standard pre-programmed shopping list, his last generated shopping list, or a blank shopping list from which to commence his shopping list preparation. [Barnett at column 10 lines 28-47]

Column 13 lines 1-10 in Barnett states that:

In accordance with the present invention, the marketing analysis, coupon packaging, and coupon package distribution functions carried out by the coupon distributor 16 may be carried out at the central data repository, i.e. Internet web site. Further, the coupon redemption and user redemption information processing functions individually carried out by the coupon redemption center 13 and the individual retail stores 10 may be combined into a single redemption center, as shown by the dotted line in FIG. 1. The physical layout of the functions within the system of the present invention is a matter of practicality and choice of the systems designer and does not impact the utility of the present invention. [Barnett at column 13 lines 1-10]

Column 12 lines 37-63 in Barnett states that:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be

further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 37-63]

Column 4 lines 64-67 in Barnett states that:

...Alternatively, the system may enable the user to transmit electronically the printable coupon data from the coupon output buffer to the centrally located repository or directly to the retailer for electronic coupon redemption. [Barnett at column 4 lines 64-67]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claim 144 depends from independent claim 102. Claim 190 depends from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 144 and 190 - Further Definition Over Barnett

Claims 144 and 190 define transmitting a customer's store identification from a kiosk to a computer, wherein a computer is a first store computer, determining that a store identification identifies a second store; and querying a second store level computer for a second store for customer shopping habit data associated with the customer identification. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 144 and 190. Therefore, there is no *prima facie* rejection of claims 144 and 190. Therefore, the rejections should be withdrawn.

Moreover, there is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed transmitting a customer's store identification from a kiosk to a computer, wherein a computer is a first store computer, determining that a store identification identifies a second store; and querying a second store level computer for a second store for customer shopping habit data associated with the customer identification, as defined by claims 144 and 190. For this additional reason, the inventions defined by claims 144 and 190 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 144 and 190 are improper and should be withdrawn.

Z. Rejection Under 103(a) of Claims 145-147 and 191-193

1. The Examiner's Argument

In support of the rejections of claims 145-147 and 191-193 under 35 USC 103(a) as being unpatentable over Barnett, the examiner states that:

Claim 145, 146, 147, 191-193: Barnett discloses the method, system according to claim 102, 148. Barnett further discloses that coupons can be issued to entice a first time customer 1, lines 50-55), that a consumer use of coupons can be tracked and the coupons sent to the user can be varied in response to this tracking (col 12, lines 50-63), and that the value of a coupon can be varied depending on the demographics and usage habits of a user (col 13, lines 24-35). [Office action page 13 line 21 to page 14 line 13.]

Column 1 lines 50-55 in Barnett states that:

The notion of issuing product redemption coupons to consumers was an innovative idea to entice consumers to try new products in the hope that, after the first try of a new product at a coupon discounted price, they would become repeat customers at the regular price. Coupons are effective tools used in launching new products. [Barnett at column 1 lines 50-55]

Column 12 lines 50-63 in Barnett states that:

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be

analyzed over a time period and used to determine the subsequent targeted packages. [Barnett at column 12 lines 50-63]

Column 13 lines 24-35 in Barnett states that:

The amount of redemption discount included with a coupon downloaded to a user may be varied depending on certain demographic information that the system has about the user. For instance, the system may provide a certain value for known users of a brand (which information it will obtain by demographic inquiry or through previous redemptions in the system), and it may provide a higher discount in order to provide an incentive to users of a competitive brand. The ability to vary the value of a discount offer in accordance with such demographic and usage data is a unique advantage offered by the system of the present invention and heretofore unavailable in the prior art. [Barnett at column 13 lines 24-35]

2. Dependency On Allowable Claims

In reply, the applicants respectfully traverse these rejections because they are not supported by either substantial evidence or proper legal conclusions.

Claims 145-147 depend from independent claim 102. Claims 191-193 depend from independent claim 148. Therefore, these rejections are improper and should be withdrawn for at least the reasons given above for claims 102 and 148.

3. Claims 145 and 191 - Depending a Value of an Incentive Offer Provided at a Kiosk Upon Whether a Customer Received a Prior Incentive

Claims 145 and 191 define depending a value of an incentive offer provided at a kiosk upon whether a customer received a prior incentive. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 145 and 191. Therefore, there is no *prima facie* rejection of claims 145 and 191. Therefore, the rejections should be withdrawn.

Moreover, there is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed depending a value of an incentive offer provided at a kiosk upon whether a customer received a prior incentive, as defined by claims 145 and 191. For this additional reason, the inventions defined by claims 145 and 191 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of

claims 145 and 191 are improper and should be withdrawn.

4. Claims 146 and 192 - A Value That Increases If a Prior Incentive Offer To a Customer Was Not Accepted

Claims 146 and 192 define a value that increases if a prior incentive offer to a customer was not accepted. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 146 and 192. Therefore, there is no *prima facie* rejection of claims 146 and 192. Therefore, the rejections should be withdrawn.

Moreover, there is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed a value that increases if a prior incentive offer to a customer was not accepted, as defined by claims 146 and 192. For this additional reason, the inventions defined by claims 146 and 192 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 146 and 192 are improper and should be withdrawn.

5. Claims 147 and 193 - Incentive Criteria Depend Upon Time Since a Customer's Last Purchase

Claims 147 and 193 define incentive criteria depend upon time since a customer's last purchase. However, the examiner does not specify what teachings of Barnett correspond to the limitations of claims 147 and 193. Therefore, there is no *prima facie* rejection of claims 147 and 193. Therefore, the rejections should be withdrawn.

Moreover, there is no teaching or suggestion in the cited disclosure of Barnett that enables the claimed incentive criteria depend upon time since a customer's last purchase, as defined by claims 147 and 193. For this additional reason, the inventions defined by claims 147 and 193 would not have been obvious to one of ordinary skill in the art in view of the Barnett and Spector patents. Therefore, the rejections of claims 147 and 193 are improper and should be withdrawn.

III. Conclusion

Therefore, independent claims 102, 148, 194, 195, 197-202, 206, 210, and 211, and dependent claims 103-147, 149-193, 203-205, and 207-209, are patentably distinguishable over the cited references for the reasons given above, and the application is believed to be in condition for formal allowance.

Respectfully Submitted,

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